

Applicant has amended the claims so as to overcome the rejection under 35 U.S.C. § 112 and otherwise contends that all pending claims are allowable over the prior art for the reasons stated below.

Specifically, the present invention is a computer file editing system including a plurality of personal computers (or terminals) each having a computer file review means or display; at least one personal computer having a multi-tasking processing means for automatically coordinating:

1. The execution of file editing operations on a given computer file comprising edits of less than the entire computer file inputted by at least one of the users;
and
2. The transfer of data corresponding with and limited to such edits via interconnecting means to the others in the system in a predetermined manner;

wherein the file editing operations and corresponding limited data transfer occur on a substantially real-time basis relative to said edit inputs to permit the plurality of remote users to review said edits substantially contemporaneously with the corresponding input thereof and execution of said file editing operations. None of the cited references or other prior art discloses or suggests such a system, nor provides or even recognizes the advantages associated therewith.

Of primary importance, Swank fails to disclose a system having a plurality of personal computers with corresponding computer file review means, or a personal computer with multi-tasking processing means for coordinating the execution of file editing operations on a given computer file and the transfer of data corresponding with and limited to the edits to others within the system in a predetermined manner to allow for substantially contemporaneous review upon edit inputs, or a combination that otherwise operates so that file editing operations and transfer of data occur on a substantially real-time basis relative to edit inputs to permit the system users to review edits via their respective edit review means substantially contemporaneously with the corresponding input thereof and execution of the file editing operations. The Office Action dated March 15, 1993, fails to address these specified failures of the prior art. The Examiner's understanding and recognition of this failure is critical since it goes to the very essence of the present invention; i.e., a computer file editing system that allows a plurality of users at remote locations to review file edits substantially contemporaneously with the input thereof, and that can be practiced in a variety of practical configurations. Indeed, this distinction from the prior art must be appreciated to fully understand the combinative benefits of the claimed system components, including the addition of voice communication capabilities between system users so as to allow review/

discussion of edits substantially contemporaneously with the corresponding inputs.

With specific regard to Swank, and in marked contrast to the present invention, Swank discloses a sequential operating arrangement which is not capable of permitting remote users to review edits substantially contemporaneously with the edit inputs. Rather, Swank discloses an arrangement wherein (see Column 3, lines 27-56):

1. First, a computer file residing at a host 20 and corresponding host-computed hash value are copied to a diskette 36 at PC 30;
2. Then, PC-generated hash values are computed for each line of the copied computer file and a non-editable hash file 32 is created containing the host-computed hash value and PC-generated hash values and stored on diskette 36;
3. Then, the copied file is edited at PC 30;
4. Then, hash values are calculated at PC 30 for each line of the edited, copied file and compared line-by-line with the previous PC-generated hash values to identify the lines within the file which have changed;
5. Then, and only after the proper user input of commands at PC 30 (see also Column 7, lines 35-48), the changed lines are transmitted to host 20, along with control information specifying the location in the original

file stored at host 20 of lines to be deleted or retained;

6. Then, the hash value of the original entire file is recomputed by host 20 and compared to the entire file hash total previously stored at terminal 30;
7. Then, and only if the comparison yields a "match", is the original file at host 20 updated;
8. Then, the terminal hash file is rewritten to reflect the update.

It should be appreciated that the sequential operations and arrangement described by Swank simply do not contemplate or allow for a plurality of remote users to review edits substantially contemporaneously with the input thereof.

In this regard, for example, even assuming that host 20 was provided with a computer file review means, a user at host 20 would not be in a position to review an edited computer file reflecting edits made at PC 30 until all of operations 1-6 above are completed since as indicated (see also Column 5, lines 45-55) the original file at host 20 is not updated until the operation 6 noted above is completed, which in turn requires completion of operations 1-5 noted above. Further, it seems apparent that the creating/transmitting/comparing of hash files and the need for proper user command inputs at PC 30 before edit data transfer to host 20 yields an arrangement essentially requiring the completion of editing operations before the transmission of data corresponding with edits from PC 30 to host

20. This renders the Swank arrangement incapable of modification to allow a plurality of users to review edits substantially contemporaneous with the input thereof, as per the present invention.

Additionally, Swank's primary purpose for creating, transmitting and comparing hash files is to reduce the volume of file edit communications while insuring that the original file at host 20 is accurately edited. Swank reflects no concern with the provision of a system which permits a plurality of remote users to review edits made to a given file substantially contemporaneously with the edit inputs and file editing operations.

In view of the foregoing, Applicant submits that Swank fails to disclose or render obvious the presently claimed invention. In the latter regard, Swank offers no suggestion or motivation in terms of problem recognition or otherwise to extend or combine Swank with any other prior art to yield the claimed invention. Indeed, to do so would seem to compromise or preclude the utilization of the very invention disclosed by Swank.

Based upon the nature of the rejections in the parent and present case to date, Applicant contends that the Examiner has failed to properly consider the differences between the claimed subject matter and the prior art, and has failed to properly consider such subject matter "as whole" as of the time the present application was filed. Rather, by failing to address

how Swank or any the other previously cited art discloses or even suggests a system as claimed which permits a plurality of users at different remote locations to review computer file edits substantially contemporaneous with corresponding inputs, it appears that the Examiner has, in effect, examined the claims in light of the inventor's own teaching in the application.

The Court of Appeals for the Federal Circuit has clearly stated its position on such issues. That is, an evaluation of the obviousness of claims must not be made with the benefit of hindsight using the present application as a blueprint to reconstruct the claimed invention from the references. In re Fritch, 23 U.S.P.Q. 2d 1780, 1784 (Fed. Cir. 1992). To do otherwise is "[t]o imbue one of ordinary skill in the art with knowledge of the invention ... where no prior art reference or references of record convey or suggest that knowledge [and] ... to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher". W.L. Gore & Assoc., Inc. v. Garlock, Inc., 220 U.S.P.Q. 303, 312-13 (Fed. Cir. 1983). Furthermore, and of particular importance here, the Court of Appeals for the Federal Circuit has indicated that examination should not be based upon the obviousness of "features", but rather the invention as a whole, Interconnect Planning Corp., 227 U.S.P.Q. at 550, 551 and that "this is essential for combination inventions, for generally all combinations are of known elements." Id. at 551. Thus, when an invention is in combination of elements, it is not

enough for an Examiner to believe that all of the claimed elements are found. There must be some reason or suggestion or incentive in the prior art references to support the claimed combination. Id. at 551. In the absence of such suggestion or incentive to combine the claimed combination cannot be deemed to be obvious. In re Fritch, 23 U.S.P.Q. 2d at 1783.

In summary, unless the Examiner can show "some objective teaching in the prior where that knowledge is generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references", In re Fine, 5 U.S.P.Q. 2d at 1598, and unless the Examiner can show that such a combination would result in the claimed invention, the Examiner has fallen short of "the burden under Section 103 to establish a prima facie case of obviousness". Id.

Here, it is respectfully submitted that the Examiner has fallen short of the burden under Section 103. Swank and all other references of record fail to disclose, individually or in any combination, a system comprising a plurality of interconnected remote PCs or terminals each having computer file review means and including at least one multi-tasking means for coordinating file editing operations and the transfer of corresponding edit data wherein the remote users can review edits substantially contemporaneous with the edit inputs. Further, the Examiner has failed to address how any of the prior

art teachings would motivate or otherwise suggest the claimed system.

In further support of patentability, Applicant submits herewith the following "secondary consideration" evidence:

An affidavit by Mr. John Klug, the inventor of the present invention, stating that, in his opinion, the product offered under the tradename "ASPECTS" is covered by one or more of the pending claims and that the long-felt need addressed by and commercial success of the ASPECTS product, as reflected by articles attached to such affidavit, are due at least in large part to the utilization of the claimed invention. Such articles are as follows:

1. "Plugging the Gap Between E-Mail and Video Conferencing", The New York Times, June 23, 1991.
2. "A Whole New PC Aspect", USA Today, October 21, 1991.
3. "Mac Applications Prove Windows is No Substitute for the Real Thing", INFOWORLD, August 6, 1990, p. 98.
4. "Groupware Grows Up" MacUser, June 1991, pp. 207-211.

Additional affidavits of a like nature will be provided as necessary. Secondary consideration evidence, including evidence of long-felt need and commercial success is relevant to the question of non-obviousness. Graham v. John Deere, 383 U.S.P.Q.